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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,017	07/21/2003	Gary Mitchell Davenport	IAM 0574 PA	5722

27752 7590 04/11/2006

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EXAMINER	
DAVIS, RUTH A	

ART UNIT	PAPER NUMBER
1651	

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/624,017	DAVENPORT ET AL.	
	Examiner	Art Unit	
	Ruth A. Davis	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *23-26,29-33,35-36* is/are rejected.

7)☒ Claim(s) *27,28 and 34* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Applicant's response filed on February 2, 2006 has been received and entered into the case. Claims 23 – 36 are pending and have been considered on the merits. All arguments have been fully considered.

Claim Objections

1. Claims 27, 28 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 23 – 26, 30 – 33 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Sunvold et al. (6039952)

Applicant claims a process for controlling fecal hair excretion and trichobezoar formation in an animal, the process comprising feeding the animal a composition comprising about 10 – 42% crude protein, 4 – 30% fat, 1 – 25% total dietary fiber and a supplemental fiber source; wherein the animal is a cat or rabbit. Specifically the composition comprises about 1 – 13% supplemental fiber source. The supplemental fiber source is selected from at least one fermentable fiber; a blend of at least two fermentable fibers; a blend of at least one fermentable fiber and a cellulose ether; a blend of at least one fermentable fiber, a cellulose ether and mineral oil; and a blend of at least one fermentable fiber and at least one non-fermentable fiber. Specifically, the fermentable fiber is selected from beet pulp, gum arabic, FOS and blends thereof; or beet pulp; and is present at about 6 – 12%; or 10 – 12% supplemental fiber. More specifically, the supplemental fiber is about 6% beet pulp, about 2% gum arabic, about 1.5% FOS; or about 12% beet pulp.

Sunvold teaches a method for improving clinical signs in an animal with renal disease, the method comprising feeding the animal a composition comprising about 10 – 32% crude protein, 8 – 20% fat, 3 – 25% total dietary fiber, and about 1 – 11% fermentable fiber (or supplemental fiber) (col.2 line 4-15). The fermentable fibers are selected from beet pulp, gum arabic, FOS and mixtures thereof (col.2 line 32-41). The composition is fed to companion animals such as a cat (col.3 line 45-50).

Although Sunvold does not teach that the method is effective for controlling fecal hair excretion and trichobezoar formation, the method steps are the same. In the instant case the

claims recite feeding the same composition, in the same amounts, to the same population, as disclosed in the prior art. Because the same composition is fed to the same population in the same amount, the result of that feeding must necessarily be the same disclosed by applicant. Otherwise applicant's invention could not function as disclosed. Moreover, by practicing the methods of Sunvold, one would inherently be practicing the claimed method of controlling fecal hair excretion and trichobezoar formation.

While Sunvold does not specifically teach the composition comprises about 12% beet pulp; or 6% beet pulp, about 2% gum arabic, about 1.5% FOS; Sunvold does teach about 1 – 11% supplemental, fermentable fibers wherein the fiber is beet pulp, gum arabic, FOS and mixtures thereof. The claimed limitation "about 12% beet pulp" allows for amounts slightly above and below 12%. The claimed limitation "about 6% beet pulp, about 2% gum arabic, about 1.5% FOS" allows for amounts slightly above and below the recited amounts. Sunvold also provides for amounts slightly above 11%, by reciting "about 1 – 11%". Therefore, one in the art would reasonably expect that about 1 – 11% of fermentable fibers selected from beet pulp, gum arabic, FOS and mixtures thereof is sufficient specificity to constitute about 12% beet pulp; or about 6% beet pulp, about 2% gum arabic, and about 1.5% FOS. (See MPEP 2131.03 II).

Therefore, the reference anticipates the claimed subject matter.

4. Claims 23 – 26, 29 – 33 and 35 – 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Reinhart.

Applicant claims a process for controlling fecal hair excretion and trichobezoar formation in an animal, the process comprising feeding the animal a composition comprising about 10 –

42% crude protein, 4 – 30% fat, 1 – 25% total dietary fiber and a supplemental fiber source; wherein the animal is a cat or rabbit. Specifically the composition comprises about 1 – 13% supplemental fiber source. The supplemental fiber source is selected from at least one fermentable fiber; a blend of at least two fermentable fibers; a blend of at least one fermentable fiber and a cellulose ether; a blend of at least one fermentable fiber, a cellulose ether and mineral oil; and a blend of at least one fermentable fiber and at least one non-fermentable fiber. Specifically, the fermentable fiber is selected from beet pulp, gum arabic, FOS and blends thereof; beet pulp; or beet pulp and cellulose; and is present at about 6 – 12%; or 10 – 12% supplemental fiber. More specifically, the supplemental fiber is about 6% beet pulp, about 2% gum arabic, about 1.5% FOS; about 6% beet pulp and about 6.5% cellulose; or about 12% beet pulp.

Reinhart teaches a process for treating GI disorders in an animal, the process comprising feeding an animal a composition comprising about 30% crude protein, about 20% fat, about 10% total dietary fiber, and about 3 – 9% of a supplemental, fermentable fiber (col.2). The supplemental fiber may be beet pulp, gum arabic, FOS, cellulose and mixtures thereof (examples). The animals are pets (abstract) to include cats (col.2 line 14-19, col.3 line 15-20, example 5).

Although Reinhart et al. does not teach that the method is effective for controlling fecal hair excretion and trichobezoar formation, the method steps are the same. In the instant case the claims recite feeding the same composition, in the same amounts, to the same population, as disclosed in the prior art. Because the same composition is fed to the same population in the same amount, the result of that feeding must necessarily be the same disclosed by applicant.

Otherwise applicant's invention could not function as disclosed. Moreover, by practicing the methods of Reinhart et al., one would inherently be practicing the claimed method of controlling fecal hair excretion and trichobezoar formation.

While Reinhart does not specifically teach the compositions comprise the claimed amounts of each fiber, Reinhart does teach about 3 – 9% supplemental, fermentable fibers wherein the fiber is beet pulp, gum arabic, FOS cellulose and mixtures thereof. Since the claims each recite "about" before the recited ranges and amounts, the ranges allow for slightly more or less than the recited amount. Specifically, "about 10 – 12% supplemental fiber" allows for slightly below and above the range. The claimed limitation "about 6% beet pulp, about 2% gum arabic, about 1.5% FOS" allows for amounts slightly above and below the recited amounts. The limitation "about 6% beet pulp and about 6.5% cellulose" allows for amounts slightly above and below the recited amounts. Finally, "about 12% beet pulp" allows for amounts slightly above and below 12%. Reinhart also provides for amounts slightly below and above 3 - 9%, by reciting "about 3 – 9%". Therefore, one in the art would reasonably expect that about 3 – 9% of fermentable fibers selected from beet pulp, gum arabic, FOS, cellulose and mixtures thereof is sufficient specificity to constitute about 6% beet pulp, about 2% gum arabic, and about 1.5% FOS; about 6% beet pulp and about 6.5% cellulose; and about 12% beet pulp; or. (See MPEP 2131.03 II).

Therefore, the reference anticipates the claimed subject matter.

Response to Arguments

Applicant argues that the references do not teach or suggest the functionally limitations of controlling fecal hair excretion or trichobezoar formation in cats or rabbits, thus cannot anticipate the claims.

However, this argument fails to persuade because as stated in the above rejections, the references teach administering the same compositions, in the same amounts, to the same populations as disclosed in the prior art. Moreover, by practicing the methods of the prior art, one would inherently be controlling fecal hair excretion and trichobezoar formation. It is further noted that the references clearly identify cats in the methods. Therefore, the claims stand rejected for the reasons stated here and above.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 32 – 33 and 35 – 36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reinhart.

Applicant claims a process for controlling fecal hair excretion and trichobezoar formation in an animal, the process comprising feeding the animal a composition comprising about 10 – 42% crude protein, 4 – 30% fat, 1 – 25% total dietary fiber and a supplemental fiber source; wherein the animal is a cat or rabbit. The supplemental fiber source is present at about 10 – 12%; is about 6% beet pulp, about 2% gum arabic, and about 1.5% FOS; is about 6% beet pulp and about 6.5% cellulose; or is about 12% beet pulp.

Reinhart teaches a process for treating GI disorders in an animal, the process comprising feeding an animal a composition comprising about 30% crude protein, about 20% fat, about 10% total dietary fiber, and about 3 – 9% of a supplemental, fermentable fiber (col.2). The supplemental fiber may be beet pulp, gum arabic, FOS, cellulose and mixtures thereof (examples). The animals are pets (abstract) to include cats (col.2 line 14-19, col.3 line 15-20, example 5).

Although Reinhart does not teach that the method is effective for controlling fecal hair excretion and trichobezoar formation, the method steps are the same. In the instant case the claims recite feeding the same composition, in the same amounts, to the same population, as disclosed in the prior art. Because the same composition is fed to the same population in the same amount, the result of that feeding must necessarily be the same disclosed by applicant.

Otherwise applicant's invention could not function as disclosed. Moreover, by practicing the methods of Reinhart, one would inherently be practicing the claimed method of controlling fecal hair excretion and trichobezoar formation.

Reinhart does not specifically teach the method wherein the claimed amounts of supplemental fibers are fed to the animal. However, Reinhart does teach about 3 – 9% supplemental, fermentable fibers wherein the fiber is beet pulp, gum arabic, FOS, cellulose and mixtures thereof. The claimed limitations each allow for amounts slightly above and below the recited amounts since they each recite "about" before the amounts. Specifically, "about 10 – 12%" allows for slightly below 10%; the limitations "about 6% beet pulp, about 2% gum arabic, about 1.5% FOS" and "about 6% beet pulp and about 6.5% cellulose" allows for amounts slightly above and below the recited amounts; and "about 12% beet pulp" allows for amounts slightly above and below 12%. Reinhart also provides for amounts slightly above 9%, by reciting "about 3 – 9%". At the time of the claimed invention, it would have been well within the purview of one of ordinary skill in the art to feed the claimed amounts of fibers to the animals of Reinhart, in following the methods of Reinhart. Furthermore, it would have been obvious to one of ordinary skill in the art to optimize the amounts of each fiber, since Reinhart teaches a variety of amounts and combinations of the instant fibers (examples). Generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). "The normal desire of scientists or artisans to improve upon what

is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages." (MPEP 2144.05(II)(A)). Moreover, at the time of the claimed invention, one of ordinary skill in the art would have been motivated by the teachings of Reinhart to optimize the amounts of fibers as a matter of routine experimentation.

Response to Arguments

Applicant argues that the references do not teach a method for controlling fecal hair excretion or trichobezoar formation; that applicant has discovered a new use for the composition; and that one in the art would not recognize the newly claimed use. Applicant further argues that to show inherency, the inherent properties must be recognized by one in the art. Applicant argues that the instant methods are directed to treating cats and rabbits, not dogs, as in the prior art and that applicant is using improper hindsight.

However, these arguments fail to persuade because as stated above, while the references do not specifically identify the methods are effective to control fecal hair excretion or trichobezoar formation, the method steps are the same. In the instant case the claims recite feeding the same composition, in the same amounts, to the same population, as disclosed in the prior art. Because the same composition is fed to the same population in the same amount, the result of that feeding must necessarily be the same disclosed by applicant. Otherwise applicant's invention could not function as disclosed. Moreover, by practicing the methods of the cited

references, one would inherently be practicing the claimed method of controlling fecal hair excretion and trichobezoar formation.

Regarding applicant's discovery of a new use for an old product that one would not recognize, and that inherent properties would not be recognized by one in the art, it is pointed out that discovery of a previously unappreciated property does not necessarily render the product or method patentably new to the discoverer. Inherent features of methods need not be recognized at the time of the invention, but only that the subject matter is in fact inherent in the prior art reference (MPEP 2112). Specifically, in the instant case the claims recite feeding the same composition, in the same amounts, to the same population, as disclosed in the prior art. Because the same composition is fed to the same population in the same amount, the result of that feeding must necessarily be the same disclosed by applicant.

Regarding applicant's assertion that the instant invention is directed to cats and rabbits, not dogs, it is noted that Reinhart specifically teaches the method of administering to pet animals to include cats. Moreover, Reinhart does, in fact teach administering the composition to cats. Furthermore, since Reinhart specifically identifies the method for "pet animals" and rabbits are pets, it would be well in the purview of one in the art to practice the method with rabbits, since they are also known as "pet animals".

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth A. Davis whose telephone number is 571-272-0915. The examiner can normally be reached on M-F 7:00 - 2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 3, 2006
AU 1651

RUTH A. DAVIS
PATENT EXAMINER